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MOTOROLA, INC. 1303 EAST ALGONQUIN ROAD IL01/3RD SCHAUMBURG, IL 60196			EXAMINER ALVAREZ, RAQUEL	
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UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES

Ex parte SCOTT A. STEELE and WILLIAM P. ALBERTH, JR.

Appeal 2009-010367
Application 09/414,121
Technology Center 3600

Before: MURRIEL E. CRAWFORD, HUBERT C. LORIN, and JOSEPH A. FISCHETTI, *Administrative Patent Judges*.

CRAWFORD, *Administrative Patent Judge*.

DECISION ON APPEAL¹

¹ The two-month time period for filing an appeal or commencing a civil action, as recited in 37 C.F.R. § 1.304, or for filing a request for rehearing, as recited in 37 C.F.R. § 41.52, begins to run from the “MAIL DATE” (paper delivery mode) or the “NOTIFICATION DATE” (electronic delivery mode) shown on the PTOL-90A cover letter attached to this decision.

STATEMENT OF THE CASE

This is an appeal from the final rejection of claims 1-2, 5-8, 11, 13, 15-17, 19, and 22. We have jurisdiction to review the case under 35 U.S.C. §§ 134 and 6 (2002).

The claimed invention is directed to systems and methods for managing subscriptions for a wireless communication device (Abstr.). Claim 1, reproduced below, is further illustrative of the claimed subject matter.

1. A method of providing service in a wireless communication network comprising the steps of:
 - providing a plurality of service options to an end user of a wireless communication device operating on said wireless communication network;
 - providing products or services to said end user in response to a subscription to one of said service options;
 - providing a quota of advertisements to the end user within a predetermined time period in lieu of receiving compensation for the subscription, wherein the provision of the advertisements is based upon a content that a user is receiving on said wireless communication device and when a subscriber will be with a predetermined distance of said a predetermined vendor at a future time;
 - determining whether the advertisements have been delivered; and
 - terminating advertisements upon reaching the quota.

The references of record relied upon by the Examiner as evidence of obviousness are:

Logan	US 5,721,827	Feb. 24, 1998
Titmuss	WO 98/47295	Oct. 22, 1998
Hall	US 6,026,375	Feb. 15, 2000
Goldberg	US 6,183,366 B1	Feb. 6, 2001

Claims 1, 2, 5-8, 11, 13, 15-17, 19, and 22 stand rejected under 35 U.S.C. § 103(a) as being unpatentable over Goldberg and Hall.

Claims 7, 8, 15, and 16 stand rejected under 35 U.S.C. § 103(a) as being unpatentable over Goldberg, Hall, and Titmuss.

We AFFIRM.

ISSUE

Did the Examiner err in asserting that a combination of Goldberg, Hall, and Titmuss renders obvious the subject matter of claims 1-2, 5-8, 11, 13, 15-17, 19, and 22?

ANALYSIS

We are not persuaded that the Examiner erred in asserting that a combination of Goldberg, Hall, and Titmuss renders obvious the subject matter of claims 1-2, 5-8, 11, 13, 15-17, 19, and 22 (App. Br. 6-12; Reply Br. 5-7). Appellants assert that Goldberg does not disclose “terminating advertisements upon reaching the quota,” as recited in independent claims 1 and 13, and disagrees that such a termination is well-known (App. Br. 6-8; Reply Br. 5-6). However, the Examiner has provided the Logan reference as evidence that “terminating advertisements upon reaching the quota” is well-known (Exam’r’s Ans. 8). As Appellants were given the opportunity to address Logan in the Reply Brief but did not do so, Appellants have not met the burden of responding to the Examiner’s presented case of obviousness. *See In re Keller*, 642 F.2d 413, 426 (CCPA 1981).

Appellants also assert that Goldberg teaches away from “terminating advertisements upon reaching the quota” (App. Br. 6-8; Reply Br. 5-6). We disagree. Goldberg does not discourage “terminating advertisements upon reaching the quota” as required for a teaching away. *See In re Gurley*, 27 F.3d 551, 553 (Fed. Cir. 1994) (a reference may be said to teach away when a person of ordinary skill, upon examining the reference, would be discouraged from following the path set out in the reference, or would be led in a direction divergent from the path that was taken by the applicant). Indeed, Appellants assert that Goldberg is silent on the issue, which would rule out discouragement (App. Br. 6).

Appellants further assert that Goldberg does not disclose “requiring user interaction to determine whether an advertisement was reviewed to be considered an advertisement that was provided in lieu of receiving compensation for the service,” as recited in independent claim 13 (App. Br. 9-11; Reply Br. 6-7). Specifically, Appellants assert that Goldberg only discloses interaction with databases, and not users. However, Goldberg discloses that databases 28, 612 include “(c) the detected user response to the advertising ... (9.3) the number of times the advertisement was accessed: (a) by any particular user; ... and (9.4) the number of favorable and/or unfavorable responses” (col. 25, ll. 30-48). Regardless of whether this information resides in databases 28, 612, the underlying data must have been acquired via user interaction.

Appellants assert that a combination of Goldberg and Hall does not render obvious “wherein the provision of the advertisements is based upon ... when a subscriber will be with a predetermined distance of said a predetermined vendor at a future time,” as recited in independent claims 1

and 13 (Reply Br. 6). First of all, this issue was first raised in a Reply Brief, was not a response to a new argument presented by the Examiner, and Appellants have not shown any cause as to why this issue was first raised in the Reply Brief. Thus, it is untimely. *See Ex parte Borden*, 93 USPQ2d 1473, 1474 (BPAI 2010) (Informative) (“the reply brief [is not] an opportunity to make arguments that could have been made in the principal brief on appeal to rebut the Examiner’s rejections, but were not.”).

Nevertheless, Hall discloses

receiving customer location information from a location determination system;... a component for determining an estimated time of arrival of the customer at each identified facility using the customer location information;... a component for determining which facility of the at least one identified facility is capable of completing the order within a predetermined window of time coinciding with the customer’s estimated time of arrival at the determined facility.

(Col. 3, l. 55 through col. 4, l. 5). Thus, Hall discloses location information at a future time, where the recited “predetermined distance” is at the facility, as recited in independent claims 1 and 13. While Hall does not disclose advertising, Goldberg is cited for the advertising component of independent claims 1 and 13. *See Keller*, 642 F.2d at 426 (one cannot show non-obviousness by attacking references individually where the rejections are based on combinations of references).

We AFFIRM the Examiner's 35 U.S.C. § 103(a) rejections of claims 1-2, 5-8, 11, 13, 15-17, 19, and 22.

No time period for taking any subsequent action in connection with this appeal may be extended under 37 C.F.R. § 1.136(a). *See* 37 C.F.R. § 1.136(a)(1) (2007).

AFFIRMED

hh

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